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EXAMINER	
LANIER, BENJAMIN E	

ART UNIT	PAPER NUMBER
2132	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/648,149	Applicant(s) SAITO, WILLIAM H.	
	Examiner Benjamin E. Lanier	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 04 June amends claim 1, and cancels claims 13-30.

Applicant's amendment has been fully considered and entered.

Response to Arguments

2. Applicant's arguments with respect to the Nobrega reference have been considered but are moot in view of the claim amendments filed 04 June 2007, which necessitated new grounds of rejection set forth below in view of Ueshima.

3. Applicant makes an initial comment with respect to the Ueshima reference by alleging "Ueshima does not disclose the concept of sending a password to a personal communications device to permit alternative access." This argument is not persuasive because Ueshima discloses a method and system for accessing an ATM with a cellular phone instead of using an ATM card (Col. 12, lines 9-15), which meets the limitation of providing alternative access to a secured component. This system utilizes passwords transmitted to the user's cellular phone (Col. 16, lines 30-48), which meets the limitation of sending a password to a personal communications device.

Claim Objections

4. Claim 1 is objected to because of the following informalities:

Change "the at least secured component" to "the at least one secured component" in lines 13-14.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-3, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueshima, U.S. Patent No. 6,731,731, in view of Fernandes, U.S. Publication No. 2003/0218066. Referring to claim 1, Ueshima discloses a method and system for accessing an ATM with a cellular phone instead of using an ATM card (Col. 12, lines 9-15), which meets the limitation of alternative access to the at least one secured component. The system utilizes a register table (Figure 1, 31) that includes the user information for each user who has registered for the authentication service (Col. 12, lines 50-52). The user information includes telephone/cell phone number of the user (Col. 12, lines 53-55 & Col. 16, lines 13-15), user id (Col. 12, lines 56-62), pager number (Col. 13, lines 1-3), and types of service available (Col. 13, lines 10-15), which meets the limitation of at least one record that includes information about each of the plurality of individuals, the information including a communication path which defines how to contact the individual's communication device and further defines a security protocol for allowing access to

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the secure component wherein the security protocol further defines whether the individual can access the secured component via an alternative path incorporating the individual's communication device. To authenticate the user at the ATM using their cellular phone, the user makes a call using their cellular phone and requests the generation of a password (Col. 16, lines 11-13). A database searches the register table for the caller's telephone number identified by the caller's number identifying unit (Col. 16, lines 13-15). If a match is found in the database for the user, a password is generated and sent to the user's cellular phone (Col. 16, lines 15-20), which meets the limitation of in response to one of the individuals seeking access to the at least one secure component, retrieving the security protocol and communications path from the at least one record. Ueshima does not disclose that the password can be requested using the ATM interface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the user of Ueshima to request a password using the ATM interface as opposed to making a call using their cellular phone since the system is designed for the user to be proximate to the ATM (Figure 1 & Col. 16, lines 30-39, which details using a radio communication interface to transmit the password from the cellular phone to the ATM) and providing a means for requesting the password using the ATM interface would be more convenient, as a user, than having to physically make a telephone call and vocally request a password or navigate through a series of menus to request a password. This meets the limitations of the controller receiving signals from the input of the at least one secure component in response to the individual manipulating the input device indicating the individual seeks alternative access to the at least one secured device, wherein the controller evaluates the signal received from the input device of the secure component. The ATM and cellular phone each include a radio

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communication interface for transmitting/receiving password data (Col. 16, lines 5-10 & 33-39), which meets the limitation of a communications interface that allows signals between the communications device carried by the individual and the controller. Ueshima discloses that the generated password is sent to the user's cellular phone through a mail server (Col. 16, lines 15-20), which meets the limitation of sending a first signal to the communications device of the individual via the public communications system in response to the individual seeking access to the at least one secure component wherein the first signal includes a uniquely generated code. Ueshima discloses that once the user receives the password on their cellular phone, the password can be transmitted to the authentication unit of the ATM via the radio communications interface (Col. 16, lines 33-35) or the user can manually input the password using a keyboard provided at the ATM (Col. 15, lines 8-14), which meets the limitation of a uniquely generated code that is to be input by the individual via the input. Once received by the ATM, the password is authenticated allowing the user to operate a bank account by the ATM (Col. 16, lines 40-45), which meets the limitation of evaluating a response signal via the secured component by the individual by comparing the response signal to the security protocol to determine whether to allow alternative access by the individual to the at least one secure component. Ueshima discloses that that authentication unit of the ATM can include the password table such that the database does not have to be contacted to reference the stored password (Col. 16, lines 56-58) and that the authentication unit has access to the register table with user information (Figure 1), which meets the limitation of a controller having access to the at least one record. However, Ueshima does not specify that the password is transmitted from the authentication unit of the ATM, to the user's cellular phone, once generated. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made for the authentication unit to include the password generation unit such that the authentication unit transmits the generated password to the user's cellular phone in addition to storing the generated password (Ueshima: Col. 16, lines 56-68) in order to provide complete financial transactions via near-proximity means that results in lower risk assignment by card issuers and resultant lower transaction fees as taught by Fernandes ([0108]).

Referring to claim 2, Ueshima discloses that prior to generation of the password, the user can be prompted for the user's name (Col. 13, lines 50-52), which meets the limitation of the security protocol comprises sending a prompt signal to the individual via the communications interface prompting the individual to enter and transmit an access code using the communications device. In response, the user enters the user name in the cellular phone (Col. 13, lines 52-54) and the user name is ultimately compared against the register table to determine whether the entered user name coincides with a registered name (Col. 14, lines 1-4). If the user's name coincide with that registered in the register table, a password is generated and sent to the user's cellular phone (Col. 14, lines 10-18 & Col. 16, lines 17-20), which meets the limitation of which meets the limitation of comparing the access code to a pre-recorded access code stored in the at least one record to ascertain whether the individual correctly entered and transmitted the access code.

Referring to claim 3, Ueshima discloses that the register table includes password invalidation conditions (Col. 13, lines 6-9) that include a limited number times the password can be used and a limited time period the password can be used (Col. 15, lines 50-65), which meets the limitation of the at least one record further includes additional security criteria and wherein

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the controller allows access to the at least one secure component only when the individual has satisfied the security protocol and the additional security criteria.

Referring to claim 5, Ueshima that the once the user receives the password on their cellular phone, the password can be transmitted to the authentication unit of the ATM via the radio communications interface (Col. 16, lines 33-35) or the user can manually input the password using a keyboard provided at the ATM (Col. 15, lines 8-14). Once received by the ATM, the password is authenticated allowing the user to operate a bank account by the ATM (Col. 16, lines 40-45), which meets the limitation of evaluating whether the individual correctly entered the access code on the input of the at least one secure component. Ueshima discloses that that authentication unit of the ATM can include the password table such that the database does not have to be contacted to reference the stored password (Col. 16, lines 56-58) and that the authentication unit has access to the register table with user information (Figure 1), which meets the limitation of a controller having access to the at least one record. However, Ueshima does not specify that the password is transmitted from the authentication unit of the ATM, to the user's cellular phone over the radio communications interface, once generated. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the authentication unit to include the password generation unit such that the authentication unit transmits the generated password to the user's cellular phone over the radio communications interface, in addition to storing the generated password (Ueshima: Col. 16, lines 56-68) in order to provide complete financial transactions via near-proximity means that results in lower risk assignment by card issuers and resultant lower transaction fees as taught by Fernandes ([0108]).

Referring to claim 6, Ueshima discloses that prior to generation of the password, the user can be prompted for the user's name (Col. 13, lines 50-52), which meets the limitation of sending a prompt signal to the individual via the communications interface prompting the individual to enter and transmit a first access code using the communications device. In response, the user enters the user name in the cellular phone (Col. 13, lines 52-54) and the user name is ultimately compared against the register table to determine whether the entered user name coincides with a registered name (Col. 14, lines 1-4), which meets the limitation of comparing the first access code to a pre-recorded access code stored in the at least one record to ascertain whether the individual correctly entered and transmitted the first access code. If the user's name coincide with that registered in the register table, a password is generated and sent to the user's cellular phone (Col. 14, lines 10-18 & Col. 16, lines 17-20), which meets the limitation of sending a second access code to the communications device in response to determining that the individual correctly entered and transmitted the first access code. Ueshima that the once the user receives the password on their cellular phone, the password can be transmitted to the authentication unit of the ATM via the radio communications interface (Col. 16, lines 33-35) or the user can manually input the password using a keyboard provided at the ATM (Col. 15, lines 8-14). Once received by the ATM, the password is authenticated allowing the user to operate a bank account by the ATM (Col. 16, lines 40-45), which meets the limitation of evaluating whether the individual successfully entered the second access code on the input of the secure component before allowing access to the secure component.

Referring to claim 7, Ueshima discloses that the cellular phone includes means allowing communication over a cellular phone network (Figure 1, 110) between the cellular phone (Figure

1, 111) and the ATM (Figure 1, 60), which meets the limitation of the communications interface comprises a modem that is adapted to provide cellular telephone communication between the controller and cellular telephone devices carried by the plurality of individuals.

Referring to claims 8, 9, Ueshima discloses that prior to generation of the password, the user can be prompted for the user's name (Col. 13, lines 50-52). In response, the user enters the user name in the cellular phone (Col. 13, lines 52-54) and the user name is ultimately compared against the register table to determine whether the entered user name coincides with a registered name (Col. 14, lines 1-4). If the user's name coincide with that registered in the register table, a password is generated and sent to the user's cellular phone (Col. 14, lines 10-18 & Col. 16, lines 17-20), which meets the limitation of the at least one record further includes supplemental commands and corresponding actions wherein the controller, in response to the receiving a supplemental command from a user, induces the system to implement the corresponding action, the supplemental command comprises an additional access code provided to the controller via the communications interface by the individual communications device.

Referring to claim 10, Ueshima discloses that if the entered user name does not coincide with registration information in the register table, an error message is displayed and not password is generated (Col. 14, lines 4-9), which prevents access to the ATM, which meets the limitation of the supplemental command induces the controller to limit access to the at least one secure component.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueshima, U.S. Patent No. 6,731,731, in view of Fernandes, U.S. Publication No. 2003/0218066 as applied to claims 1-3 above, and further in view of Nobrega, U.S. Publication No. 2002/0107791. Referring

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to claim 4, Ueshima discloses that the cellular phone transmits the password to the ATM via the radio communication interface (Col. 16, lines 33-35), but does not specify that the cellular phone location information be transmitted along with the password to the ATM. It would have been obvious to one of ordinary skill in the art at the time the invention was made in order to verify that the cellular phone is in the same geographic region as the ATM as taught by Nobrega ([0066]). This type of verification would serve to ensure that any access given to the ATM would be given to the appropriate person proximate to the ATM.

9. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueshima, U.S. Patent No. 6,731,731, in view of Fernandes, U.S. Publication No. 2003/0218066 as applied to claim 1 above, and further in view of Fung, U.S. Patent No. 6,859,882. Referring to claims 11-12, Ueshima does not disclose the authentication system remotely enabling the ATM by sending a wake-on-LAN signal to the ATM. Fung discloses an e-commerce system where sites are remotely enabled using wake on LAN signal events (Col. 69, line 53 – Col. 70, line 4), which meets the limitation of the controller is adapted to remotely enable the secure component when the controller receives an enablement signal from the individual via the communications interface, the controller remotely enables the secure component by sending a wake on LAN signal to the at least one secure component. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the ATMs of Ueshima to be remotely enabled using wake on LAN signal events in order to conserve power based on the varying demand that may be placed on the ATMs as taught in Fung (Col. 34, lines 7-39).

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 2, and 5 are provisionally rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over claims 1, 5-9, 12, 13, 15-18, 20-22 of

copending Application No. 10/648,149 in view of Rahman and Ueshima. The claims, while not

identical, are not patentably distinct from each other because they include essential the same

claim limitations with few exceptions. These exceptions are:

'149 application includes a limitation that the at least one record include information about the individual's access device, which is not claimed in the present application. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the claimed record in the present application to include information regarding the individual's access device in order to authenticate the user when using the primary access means, as opposed to the alternative access means, as taught by Rahman (Abstract & Col. 2, lines 23-43).

The present application includes a limitation that the user is prompted to enter and transmit the access code (claim 2), which is not included in the claim limitations of the '149

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application. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the user to be prompted to enter and transmit the access code in the claim limitations of the '149 application so as to suppress the risk in the event that the communications device is stolen as taught by Ueshima (Col. 16, lines 35-39).

This is a provisional obviousness-type double patenting rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

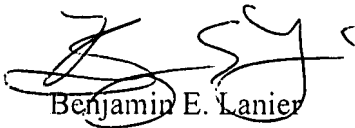
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Benjamin E. Lanier